light while operating a battery tester

Section 2144.04 of the Manual of Patent Examining Procedure (MPEP) includes, under a sub-section related to making integral, the following:

> "*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (. . . 'the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.'); **but** see *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine . . . comprising a holding structure, a base structure, and a supporting means which form 'a single integral and gaplessly continuous piece.' Nortron argued that the invention is just making integral what had been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure . . .)." (Emphasis Added.)

The claimed invention, in a manner akin to the invention described in *Schenck*, eliminates a need, perceived by the prior art, for positioning a probe light while operating a battery tester.

Page 11, lines 18-27 of the Applicant's specification (cited as prior art in the Office Action) include the following:

> "In general, when required, separate lighting equipment such as a torch is

> utilized to illuminate a battery environment during battery testing. However, employing separate lighting equipment during battery testing makes the testing and lighting equipment difficult to properly position and operate in a constrained and poorly lit environment associated with, for example, testing of batteries wherein the battery terminals are recessed in cabinets." (Emphasis Added.)

Integrating the lighting equipment with at least one Kelvin connection of a battery tester, in accordance with the present invention, eliminates the above-described need for positioning the lighting equipment. Thus, the claimed invention is patentable based on the above MPEP section.

B. Use of impermissible hindsight

> "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998).

Torches of various shapes and sizes and battery testing equipment with cables have been utilized for a number of years. However, as indicated in the cited art, torches and battery

cables have been separate (or non-integrated). The Office Action does not show any teaching or suggestion, either in the references or in the knowledge of one skilled in the art, that relates to integrating/combining a torch with a battery tester cable. Accordingly, the only teaching of such integration comes form the Applicant's own disclosure. This constitutes impermissible hindsight, on which a determination of obviousness cannot be based, as indicated in the case law cited above.

In view of the foregoing, Applicants respectfully request reconsideration and allowance of claims 1-27. Favorable action upon all claims is solicited.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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